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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,477	03/08/2001	Thomas Dodt	P20466	4933

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GREENBLUM & BERNSTEIN, P.L.C.
1941 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT PAPER NUMBER

1733

DATE MAILED: 07/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,477

Applicant(s)

DODT ET AL.

Examiner

Adrienne C. Johnstone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

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DETAILED ACTION***Specification***

1. The added subject matter filed in this continuing application which is not supported by the original disclosure in the parent application is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: It is not readily apparent to the examiner that there is support in the original disclosure for the new language in paragraphs 0029, 0031, and 0033-0035, and applicants have not specifically pointed out the support in the original disclosure for this language as per MPEP 714.02 ("Applicant should also specifically point out the support for any amendments made to the disclosure.") and 2163.06 ("Applicant should therefore specifically point out the support for any amendments made to the disclosure."). See paragraph 4 below.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

2. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim 5 limitation is already required in claim 4 (the "at least one layer of fibers oriented in the circumferential direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire" is required by claim 4 to be in the form of a woven mesh).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

I. It is not readily apparent to the examiner that there is support in the original disclosure for reciting in claim 1 "an acoustically transparent support element comprising at least one layer of fibers oriented in the circumferential direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction" or for reciting in claim 14 "the acoustically transparent support element comprising a plurality of support element layers; and at least one of the support element layers is positioned between each radially arranged insert layer", and applicants have not specifically pointed out the support in the original disclosure for this language as per MPEP 714.02 ("Applicant should also specifically point out the support for any amendments made to the disclosure.") and 2163.06 ("Applicant should therefore specifically point out the support for any amendments made to the disclosure.").

Specifically, the only parts of the original disclosure pertinent to this claim language are as follows:

1) "In the embodiment involving a woven mesh it is particularly easy to achieve the tensile strength in the circumferential direction by constructing the fibers running in this direction appropriately strong" (specification paragraph 0017);

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2) "The closed ring can thereby be constructed of a ring-shaped strip of sound-absorbing material that is looped around several times. The arrangement of the support elements is easily possible in an embodiment involving strips and also particularly advantageous, whereby it is sufficient to equip the strip with support elements only on one side should it be constructed as foil or woven mesh." (specification paragraph 0020);

3) "The acoustically transparent woven mesh 6 contains fibers that have tensile strength in the circumferential direction and provide the foamed material ring 5 the required strength with respect to the centrifugal forces" (specification paragraph 0054);

4) "In another embodiment of the invention, illustrated in Figure 3, a foamed material strip 7 of appropriate width, instead of the closed foamed material ring, is wrapped around the wheel rim 1 in at least two layers. The foamed material strip 7, wrapped in several layers, can conform to the contour of the wheel rim 1 in an easier way. More than one strip can also be used as an alternative, for example to facilitate the conformation to the contour of the wheel rim." (original parent application disclosure corresponding to the specification paragraph 0064); and

5) "In order to improve the resilience with respect to the centrifugal force, the foamed material strip also contains support elements that are constructed as woven mesh or foil. ... Each layer of the wrapped foam material strip 7 therefore also contains a layer of support elements. In this embodiment it is sufficient if only one side (which should be the outer side in the radial direction in the wrapped state) is coated with the support element [sic]." (specification paragraphs 0065-0067).

The presence of dependent claims 4 and 5 makes clear that the claim 1 language describes something other than just the woven mesh (otherwise these claims would not further limit independent claim 1), therefore claim 1 is a "subgenus" claim; it is well settled that such a

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subgenus claim is not necessarily supported by generic disclosure encompassing the subgenus (in this case the acoustically transparent support element with tensile strength in at least the circumferential direction, specification paragraph 0011) and a species upon which the subgenus reads (in this case the support element being a woven mesh having appropriately strong fibers oriented in the circumferential direction, specification paragraph 0017)(see for example the case law citations concerning subgenus limitations in MPEP 2163(I)(B)). As to claim 14, there is no support in the original disclosure for providing more than one support element layer "between each radially arranged insert layer".

II. Also, it is not readily apparent to the examiner that there is support in the original disclosure for further limiting the claim 1 "acoustically transparent support element being coupled to the insert" by reciting in claim 3 "the acoustically transparent support element comprising a plurality of support elements [sic] layers radially arranged within the insert at discrete distances from each other", and applicants have not specifically pointed out the support in the original disclosure for this language as per MPEP 714.02 ("Applicant should also specifically point out the support for any amendments made to the disclosure.") and 2163.06 ("Applicant should therefore specifically point out the support for any amendments made to the disclosure.").

Specifically, the only parts of the original disclosure pertinent to this claim 3 language are as follows:

1) "In an alternative embodiment the support element, viewed in the radial direction, is placed at discrete distances from each other [sic] in the sound-absorbing insert. ... the support element is constructed of fibers that are distributed in the sound-absorbing insert and oriented predominately in the circumferential direction of the tire" (specification paragraph 0016);

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2) “The foamed material being created therefore at least essentially contains uniformly distributed fibers that run in a preferred direction so that the sound-absorbing insert in the tire, with the appropriate use of the foamed material, has a significantly increased ability to resist the centrifugal force.” (specification paragraph 0025); and

3) “In addition, in particular for vehicle tires that are designed to be suitable for higher speeds and for which the centrifugal force up-take of the sound-absorbing insert should be appropriately larger, fiber pulp can be mixed into the material to be foamed either before or with the addition of the reacting additives.” (specification paragraph 0071).

The uniformly distributed circumferential fibers in the insert are clearly not in “layers” and not “coupled to” (distinct from) the insert.

III. Further, it is not readily apparent to the examiner that there is support in the original disclosure for further limiting the claim 1 “acoustically transparent support element comprising at least one layer of fibers oriented in the circumferential direction and having a centrifugal force resisting tensile strength, at least in the circumferential direction of the tire, wherein the centrifugal force resisting tensile strength is achieved by the at least one layer of fibers oriented in the circumferential direction” by reciting in claim 6 “the acoustically transparent support element being a perforated foil”, and applicants have not specifically pointed out the support in the original disclosure for this language as per MPEP 714.02 (“Applicant should also specifically point out the support for any amendments made to the disclosure.”) and 2163.06 (“Applicant should therefore specifically point out the support for any amendments made to the disclosure.”).

Specifically, the perforated foil embodiment in the original disclosure does not include fibers.

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IV. Finally, it is not readily apparent to the examiner that there is support in the original disclosure for reciting in claim 10 "the strip having at least one side coupled to the acoustically transparent support element", and applicants have not specifically pointed out the support in the original disclosure for this language as per MPEP 714.02 ("Applicant should also specifically point out the support for any amendments made to the disclosure.") and 2163.06 ("Applicant should therefore specifically point out the support for any amendments made to the disclosure.").

Specifically, if the acoustically transparent support element is coupled to the insert strip before the insert strip is wrapped around the wheel rim, the original disclosure describes the acoustically transparent support element being coupled to the strip on *the radially outer side* (specification paragraph 0067 clearly requires the side of the strip to be the radially outer side).

5. Claims 3, 6, and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See paragraph 3 above: applicants have not enabled the claim 3 embodiment requiring the uniformly distributed circumferentially oriented fibers in the insert to somehow be in "at least one layer" or the claim 6 embodiment requiring the perforated foil to somehow also have "at least one layer of fibers".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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See paragraphs 2 and 4 above: the claim 1 language requires the acoustically transparent support element to be "coupled to" (distinct from) the insert rather than forming part of the insert itself as required in claim 3; claim 5 fails to further limit claim 4 and is therefore redundant; and the claim 1 language requires the acoustically transparent support element to comprise the at least one layer of fibers rather than the perforated foil required in claim 6. Also, to eliminate vague language and to provide proper grammar and antecedent basis applicants should make the following amendments to the claims.

claim 1

line 5, change "comprising of" to -- comprising -- .

claim 2

line 2, delete "arranged to be";

line 4, change "being adapted to wrap" to -- wrapping -- .

claim 3

line 2, change "elements layers" to -- element layers -- .

claim 4

line 2, change "elements" to -- element -- .

claim 7

line 2, change "formed in an isotropic manner" to -- isotropic -- .

claim 8

line 2, change "formed as closed ring" to -- a closed ring -- .

claim 9

line 2, change "sound-reducing" to -- sound-absorbing -- and delete "adapted to be";

line 3, change "a ring-like manner" to -- a ring -- .

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claim 14

lines 3-4, change "between each radially arranged insert layer" to -- between adjacent radially arranged insert layers -- .

claim 15

line 2, delete "adapted to be".

claim 16

line 2, change "being adapted to add" to -- adding -- .

Allowable Subject Matter

8. Once the rejections in paragraphs 4, 5, and 7 have been overcome claims 1-17 will receive favorable consideration: Bschorr (4,399,851) and Bschorr (4,392,522) disclose examples of the prior art wheel similar to applicants' but do not disclose or suggest resisting centrifugal forces by orienting fibers in the acoustically transparent support element in the circumferential direction.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (703)308-2059. The examiner can normally be reached on Monday-Friday, 10:00AM-6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703)308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9311 for regular communications and (703)872-9310 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Adrienne C. Johnstone
Primary Examiner
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Adrienne Johnstone
July 12, 2002

A handwritten signature in black ink, reading "Adrienne C. Johnstone". The signature is written in a cursive style with a large, sweeping initial 'A' and a long horizontal stroke at the end.